

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**Patent Application**

5 Applicant(s): Grande et al.  
Case: 2-1  
Serial No.: 10/787,380  
Filing Date: February 26, 2004  
Group: 2841  
10 Examiner: Abiy Getachew  
  
Title: Method and Apparatus for Mounting a Modem to a Carrier Assembly

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15 APPEAL BRIEF

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
20 Alexandria, VA 22313-1450

Sir:

Appellant hereby replies to the non-final Office Action, mailed October 21, 2011.  
25 A request to reinstate the appeal is submitted herewith. Appellant's Appeal Brief in an Appeal of the final rejection of claims 1 through 20 was submitted on August 30, 2011.

Appellants respectfully request that this Appeal be allowed to proceed to the Appeal Board, and that any further delay is a prejudice to Appellants and a denial of Appellants' right to a Final Agency Decision. Appellants note that prosecution has been reopened for  
30 consideration of a secondary reference that is not even prior art.

REAL PARTY IN INTEREST

The present application is assigned to Agere Systems Inc., as evidenced by an assignment recorded on February 26, 2004 in the United States Patent and Trademark Office at  
35 Reel 015030, Frame 0498. The assignee, Agere Systems Inc., is the real party in interest.

RELATED APPEALS AND INTERFERENCES

There are no related appeals and interferences.

STATUS OF CLAIMS

5           The present application was filed on February 26, 2004 with claims 1 through 20.  
The current Office Action contains a new objection to FIGS. 2 and 3. Claims 1 through 20 are  
presently pending in the above-identified patent application. Claims 1-4, 6-11, 13-17 and 19-20  
were rejected under 35 U.S.C. §103(a) as being unpatentable over Watts Jr. (United States Patent  
No. 6,963,757) in view of Weidner (United States Patent No. 7,234,967). Claims 5, 12 and 18  
10 were rejected under 35 U.S.C. §103(a) as being unpatentable over Watts Jr. (United States Patent  
No. 6,963,757) in view of Downie (United States Patent No. 5,471,368). Claims 1, 8, and 14 are  
being appealed.

STATUS OF AMENDMENTS

15           There have been no amendments filed subsequent to the final rejection.

SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 1 requires a modem module (FIG. 1: 200) for connecting to a  
carrier assembly (page 3, lines 1-30; FIG. 1: 170), comprising: circuitry for interfacing with a  
20 telephone line (page 2, lines 7-12); and one or more solder pads (FIG. 1: 160) for connecting a  
signal line of the modem module to the carrier assembly (page 2, lines 16-18, and page 4, lines  
3-9).

Independent claim 8 requires a method for fabricating a modem module for  
connection to a carrier assembly (page 4, lines 1-24), comprising the steps of: providing circuitry  
25 on a printed circuit board for interfacing with a telephone line (page 2, lines 7-12); and providing  
one or more solder pads (FIG. 1: 160) on the printed circuit board for connecting a signal line of  
the modem module to the carrier assembly (page 2, lines 16-18, and page 4, lines 3-9).

Independent claim 14 requires a printed circuit board, comprising: modem

circuitry for interfacing with a telephone line (page 2, lines 7-12); and one or more solder pads (FIG. 1: 160) for connecting a signal line of the modem circuitry to a carrier assembly (page 2, lines 16-18, and page 4, lines 3-9).

5            STATEMENT OF GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

             Claims 1-4, 6-11, 13-17 and 19-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Watts Jr. (United States Patent No. 6,963,757) in view of Weidner (United States Patent No. 7,234,967). Claims 5, 12 and 18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Watts Jr. (United States Patent No. 6,963,757) in view of  
10   Downie (United States Patent No. 5,471,368). Claims 1, 8, and 14 are being appealed.

ARGUMENT

Drawing Objection

The current Office Action contains a new objection to FIGS. 2 and 3. The formal drawings were submitted on April 14, 2004. The Examiner now indicates that FIGS. 2 and 3 are unclear with their bold faces. The formal versions of FIGS. 2 and 3, however, do not contain any bold face text. Appellants query whether the Examiner was reviewing the original informal drawings. In any event, Appellants propose to address any concerns of the Examiner with regard to the figures or any other formal matters following resolution of the present Appeal.

Independent Claims 1, 8 and 14

Independent claim 1, 8 and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Watts Jr. in view of Weidner. Claims 1, 8, and 14 are being appealed.

Regarding claim 1, for example, the Examiner asserts that Watts Jr. discloses a modem card (FIG. 2, 15) for connecting to a carrier assembly (FIG. 2, 18), comprising: circuitry (FIG. 2) for interfacing with a telephone line (FIG. 2, 10); and at least one signal line of the modem module connected to the carrier assembly through an edge connector (FIG. 2, 32).

The Examiner acknowledges that Watts Jr. do not disclose the modem having one or more solder pads for connecting the signal line therefrom the modem onto the carrier assembly.

The Examiner asserts, however, that Weidner discloses a printed circuit board assembly (FIG. 7, 104) having a plurality of conductive pads (FIG. 7, 184, 186, 188) disposed at the edge of the printed circuit board thereof, wherein at least one of the conductive pads is provide a solder pad (FIG. 7, 184; col. 6, line 17).

First, Weidner is not prior art. Weidner was filed on Nov. 15, 2005, and the priority date of the present application is Feb. 26, 2004. Further, Weidner has apparently been cited for its disclosure of solder pads on a circuit board. Appellants are not claiming solder pads on a circuit board.

Rather, independent claim 1, for example, recites a *modem module* for connecting to a carrier assembly, *comprising*: circuitry for interfacing with a telephone line; and *one or more*

*solder pads for connecting a signal line of said modem module to said carrier assembly.*

In one aspect of the present invention, a modem module is provided that may be attached to a motherboard and thereby eliminates the need to recertify the motherboard. Appellants note that the Examiner does not allege that either Watts Jr. or Weidner, alone or in combination, discloses *solder pads on a modem module*, as variously required by each independent claim. The Examiner references the solder pads 184 in FIG. 7 of Weidner, *but these are not solder pads on a modem module. Again, Weidner is not prior art.*

Appellants submit that the present invention provides a patentable advancement in how the two assemblies are interconnected. In particular, Appellants are claiming a particular configuration of a “modem module” that is not disclosed or suggested by Watts et al. (even when combined with Weidner, which is not even prior art).


Thus, Watts Jr. does *not* disclose or suggest one or more solder pads (**on a modem module**) for *connecting a signal line of a modem module to a carrier assembly*. Independent claims 1, 8, and 14 require one or more solder pads (**on a modem module**) for connecting a *signal line of said modem module* to said carrier assembly.

Appellants respectfully request withdrawal of the rejection of independent claims 1, 8 and 14.

The rejections of the independent claims under section 103 in view of Watt et al. and Weidner et al., alone or in combination, are therefore believed to be improper and should be withdrawn. The remaining rejected dependent claims are believed allowable for at least the reasons identified above with respect to the independent claims.

The attention of the Examiner and the Appeal Board to this matter is appreciated.

Respectfully,

  
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Date: January 23, 2012

APPENDIX

1. A modem module for connecting to a carrier assembly, comprising:  
circuitry for interfacing with a telephone line; and  
5 one or more solder pads for connecting a signal line of said modem module to said carrier assembly.
2. The modem module of claim 1, further comprising a tip/ring connector for interfacing with said telephone line.
- 10 3. The modem module of claim 1, further comprising a connection to a tip/ring connector.
4. The modem module of claim 1, wherein said carrier assembly is a motherboard.
- 15 5. The modem module of claim 1, wherein said one or more solder pads are soldered to corresponding one or more solder pads on said carrier assembly.
6. The modem module of claim 1, wherein said modem assembly is fabricated on a printed circuit board.
- 20 7. The modem module of claim 1, wherein said modem assembly is an integrated device.
8. A method for fabricating a modem module for connection to a carrier assembly, comprising the steps of:  
25 providing circuitry on a printed circuit board for interfacing with a telephone line;  
and  
providing one or more solder pads on said printed circuit board for connecting a signal line of said modem module to said carrier assembly.

9. The method of claim 8, further comprising the step of providing a tip/ring connector for interfacing with said telephone line.

10. The method of claim 8, further comprising the step of connecting to a tip/ring connector.

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11. The method of claim 8, wherein said carrier assembly is a motherboard.

12. The method of claim 8, further comprising the step of soldering said one or more solder pads to corresponding one or more solder pads on said carrier assembly.

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13. The method of claim 8, further comprising the step of fabricating said modem assembly on a printed circuit board.

14. A printed circuit board, comprising:

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modem circuitry for interfacing with a telephone line; and

one or more solder pads for connecting a signal line of said modem circuitry to a carrier assembly.

15. The printed circuit board of claim 14, further comprising a tip/ring connector for interfacing with said telephone line.

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16. The printed circuit board of claim 14, further comprising a connection to a tip/ring connector.

17. The printed circuit board of claim 14, wherein said carrier assembly is a motherboard.

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18. The printed circuit board of claim 14, wherein said one or more solder pads are soldered to corresponding one or more solder pads on said carrier assembly.

19. The printed circuit board of claim 14, wherein said modem assembly is fabricated on a printed circuit board.

20. The printed circuit board of claim 14, wherein said modem assembly is an integrated device.



EVIDENCE APPENDIX

There is no evidence submitted pursuant to § 1.130, 1.131, or 1.132 or entered by the Examiner and relied upon by appellant.

RELATED PROCEEDINGS APPENDIX

There are no known decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of 37 CFR 41.37.